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09/494,156	01/28/2000	Christopher J. Fitzgerald	99-642	3098

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EXAMINER

BROWN, TIMOTHY M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/494,156

Applicant(s)

FITZGERALD ET AL.

Examiner

Tim Brown

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This final Office action is responsive to Applicants' amendment submitted April 15, 2003 (Paper No. 5).

Claim Rejections - 35 USC § 101

2. Applicants' argue the rejection of claims 1-16 under 35 U.S.C. §101 is improper. Applicants' arguments are persuasive. Thus, the rejection of claims 1-16 under 35 U.S.C. §101 has been withdrawn.

Response to Arguments

3. Applicants argue PR Newswire, Steele, Sheinkopf, Lonngreen and Official Notice are non-enabling references which fail to teach one of ordinary skill in the art how to make and use the claimed invention. Paper No. 5, p. 5. The Examiner respectfully disagrees. First, the Examiner notes the rejection of claims 1-16 relies upon Farrell et al. (US 6,282,518) ("Farrell") in combination with the references noted by Applicants. The Examiner further notes that Farrell incorporates by reference the disclosures of various patents in providing an enabling disclosure. Included among these is U.S. Patent No. 5,768,142 to Jacobs. Jacobs discloses an interactive computer system for identifying a product according to a number of user-specified criteria. See Abstract. Jacobs goes into great detail regarding the hardware components required to make and

Art Unit: 3625

use its interactive product-identifying computer.¹ Because Farrell incorporates the teachings of Jacobs, Farrell is enabling with respect to the technical features required to make and use Applicants' invention.

Furthermore, PR Newswire is enabling with respect to the selection steps claimed by Applicants. Applicants' invention identifies an air conditioning product by obtaining intended use information and an intended use location. Similarly, PR Newswire teaches identifying an air conditioner based on intended use information, including room size and room location. See page 1. Clearly, PR Newswire's teachings would enable one of ordinary skill to make and use the method of selecting an air conditioning product claimed by Applicants. Therefore, PR Newswire is enabling with respect to the selection steps claimed by Applicants.

4. Applicants argue Farrell is directed to non-analogous art and absent Applicants' own disclosure, there would be no motivation to combine Farrell with the teachings of PR Newswire, Steele, Sheinkopf, Lonngren or Official Notice (referred to collectively as "the noted references"). Paper No. 5, p. 5. The Examiner respectfully disagrees. It is noteworthy that the noted references are directed to evaluating a number of criteria in making a product selection, namely the selection of an air conditioner. For example, Lonngren states the selection of an air conditioner should consider the size of the room

¹ Jacobs provides the following detailed description:

The computer 13 preferably has mini-tower chassis with dual fans, a 90 mHz Pentium Intel chip upgradable processing system, a 32 megabyte random access memory (RAM), a sound blaster compatible sound board with a 16 bit midi capacity, a Sony internal CD-ROM, an NEC 4X bus adapter SCIS-2, an ATI Mach 64 video accelerator card with a two megabyte Vram, an Elographics touchscreen board, a non-bootable 1.44 megabyte Teac or Sony floppy disk drive, a 256k cache, a 200 watt power supply three parallel printer ports and two serial printer ports. The computer 13 is preferably loaded with Microsoft Window 95 software and Fastlynx 2.0 transfer software. Col. 5, lines 34-45.

Art Unit: 3625

to be cooled as well as the room's location. See page 2. Similarly, Farrell discloses "requesting user related information" and "utilizing the user entered information to select a vehicle having the seat best suited for the user." Col. 3, lines 58-63. Thus, Farrell and the noted references are directed to evaluating a number of user-specified criteria in making a product selection. Therefore, Farrell and the noted references do not comprise non-analogous art.

5. Applicants argue the combination of PR Newswire and Farrell fails to teach identification of an initial capacity, determining a correction factor, and application of the correction factor to the initial capacity to arrive at a corrected capacity. Paper No. 5, p. The Examiner respectfully disagrees. First, PR Newswire teaches determining an initial capacity through its disclosure of recommending an air conditioner based on the size of the room the user intends to cool. See page 2. Second, PR Newswire goes on to teach adjusting the size of the recommended air conditioner based on the location of the room the user intends to cool. *Id.* PR Newswire suggests increasing the BTU capacity of a given air conditioner by a factor of 4000 for rooms like attics and kitchens. *Id.* Therefore, PR Newswire teaches identification of an initial capacity, determining a correction factor, and application of the correction factor to the initial capacity to arrive at a corrected capacity.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over a PR Newswire Article (“Air Conditioners Are More Than Cool Air,” PR Newswire (July 23,1998)) (“*PR Newswire*”) in view of *Farrell et al.* (US 6,282,518).

Regarding claim 1, *PR Newswire* teaches a method of selecting an air conditioner including the steps of:

a merchant offering a customer a plurality of air conditioning products, each air conditioning product having a plurality of characteristics.

obtaining, by the merchant, intended use information from the customer for a desired air conditioner and an intended use location;

equating the intended use information with an intended use characteristic;

identifying a suitable air conditioner that matches the intended use product characteristic; and

identifying a suitable wherein a customer provides a merchant with an an indication (pages 1 and 2).

PR Newswire does not teach a providing a database storing a plurality of air conditioning products and their corresponding characteristics. However, *Farrell et al.* teach an online method for configuring and purchasing an industrial product including the step of placing a number of product characteristics for a plurality of industrial products on a database (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify *PR Newswire* to

Art Unit: 3625

include the teachings of *Farrell et al.* because storing a plurality of air conditioning products and their corresponding characteristics on a database would enable customers to shop for air conditioners online. Thus, modifying *PR Newswire* with the teachings of *Farrell et al.* would greatly enhance customer convenience by enabling the purchase of an air conditioner from any location with Internet access.

Regarding claim 2, *PR Newswire* and *Farrell et al.* teach all the limitations discussed under claim 1. *PR Newswire* does not expressly teach storing the database at a server location wherein the intended use information is obtained over the Internet. However, *Farrell et al.* teach an online method for configuring and purchasing industrial products (see Abstract). For the reasons discussed under claim 1, it would have been obvious to modify *PR Newswire* with the teachings of *Farrell et al.*.

Regarding claim 3, *PR Newswire* teaches offering an air conditioner to the customer from purchase (page 2).

Regarding claim 4, *PR Newswire* teaches product characteristics corresponding to an air conditioner wherein the characteristics include a BTU rating (page 2).

Regarding claim 5, *PR Newswire* teaches an interactive method for on-line selection of an air conditioning product, comprising the steps of:

a merchant offering a customer a plurality of air conditioning products, each air conditioning product having a plurality of characteristics.

obtaining, by the merchant, intended use information from the customer for a desired air conditioner and an intended use location;

equating the intended use information with an intended use characteristic;

identifying a suitable air conditioner that matches the intended use product characteristic; and

identifying a suitable wherein a customer provides a merchant with an indication (pages 1 and 2).

PR Newswire does not teach a providing a database storing a plurality of air conditioning products and their corresponding characteristics. However, *Farrell et al.* teach an online method for configuring and purchasing an industrial product including the step of placing a number of product characteristics for a plurality of industrial products on a database (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify *PR Newswire* to include the teachings of *Farrell et al.* because storing a plurality of air conditioning products and their corresponding characteristics on a database would enable customers to shop for air conditioners online. Thus, modifying *PR Newswire* with the teachings of *Farrell et al.* would greatly enhance customer convenience by enabling the purchase of an air conditioner from any location with Internet access.

Further regarding claim 5, *PR Newswire* teaches product characteristics including a BTU rating for each air conditioner (page 2). *PR Newswire* also teaches interactively obtaining intended use location area from the customer, transforming the intended use location into an acceptable BTU capacity, obtaining further intended use information, determining a correcting factor from the further intended use location information, and applying the correction factor to the acceptable BTU capacity so as to obtain a corrected BTU capacity thereby identifying a suitable air conditioner.

Regarding claim 8, *PR Newswire* teaches interactively obtaining an indication that the space above the intended use location is one of a roof, an attic and an occupied room and determining the corrected acceptable BTU capacity based on the indication relating to the space above the intended use location (page 2).

Regarding claim 15, *PR Newswire* teaches basing the corrected acceptable BTU capacity on an indication that the intended use location includes a kitchen (*Id.*).

3. Claims 6, 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over a PR Newswire Article (“Air Conditioners Are More Than Cool Air,” PR Newswire (July 23,1998)) (“*PR Newswire*”) in view of *Farrell et al.* (US 6,282,518) and *Steele* (Steel, J. “Don’t’ Get Hot and Bothered Aboput Buying AC Go to an Air-Conditioning Showroom Armed with Specific Information That Will Affect Your Cooling Needs,” Chicago Tribune (July 15, 1996)).

Regarding claims 6 and 7, *PR Newswire* and *Farrell et al.* teach all the limitations discussed under claim 5. Neither *PR Newswire* nor *Farrell et al.* expressly teach determining the acceptable BTU capacity based on an indication from the customer as to the area of exterior glass in the intended use location. However, *Steele* teaches selecting an air conditioner of appropriate BTU capacity based on the amount of window space and sun exposure in the room where the air conditioner is to be installed. At the time of Applicants’ invention, it would have been obvious to one of ordinary skill in the art, to modify *PR Newswire* and *Farrell et al.* to include determining the acceptable BTU capacity based on an indication from the customer as to the area of exterior glass in the intended use location. This combination would enable the selection of an air conditioner

Art Unit: 3625

with an appropriate BTU capacity when the area of windows and sun exposure will affect an air conditioner's performance in the intended use location.

Regarding claim 14, *PR Newswire* and *Farrell et al.* teach all the limitations discussed under claim 5. Neither *PR Newswire* nor *Farrell et al.* expressly teach determining the acceptable BTU capacity based on the number of occupants in the intended use location. However, *Steele* teaches selecting an air conditioner of appropriate BTU capacity based on the number of occupants in the room where the air conditioner is to be installed. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify *PR Newswire* and *Farrell et al.* to include the teachings of *Steele* because determining the acceptable BTU capacity based on the number of occupants in the intended use location. This combination would enable customers to select the appropriate air conditioner in instances where the number of occupants in the intended use location affects air conditioner performance.

4. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over a PR Newswire Article ("Air Conditioners Are More Than Cool Air," PR Newswire (July 23, 1998)) ("*PR Newswire*") in view of *Farrell et al.* (US 6,282,518) and *Sheinkopf* (Air-conditioner alphabet soup," Dallas Morning News (June 30, 1995)).**

PR Newswire and *Farrell et al.* teach all the limitations discussed under claim 5. Neither *PR Newswire* nor *Farrell et al.* teach determining the acceptable BTU capacity based on an indication that the air conditioner will be operated only at night. However, *Sheinkopf* teaches determining an acceptable BTU capacity for an air conditioner based on the climate of the intended use location. At the time of Applicants' invention, it would

Art Unit: 3625

have been obvious to one of ordinary skill in the art to modify *PR Newswire* and *Farrell et al.* to include the teachings of *Sheinkopf* because determining the acceptable BTU capacity based on an indication that the air conditioner will be operated only at night in order to select an air conditioner that is best-suited for the intended use location.

Sheinkopf suggests determining BTU capacity based on whether the air conditioner will be used only at night because climatic conditions are directly impacted by day and night.

5. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over a PR Newswire Article (“Air Conditioners Are More Than Cool Air,” PR Newswire (July 23, 1998)) (“PR Newswire”) in view of *Farrell et al.* (US 6,282,518) and *Lonngren* (Lonngren, B. “Get Cookin’ It’s Time to Put ‘Cool’ on the Front Burner,” Chicago Tribune (May 26, 1995)).

Regarding claim 11, *PR Newswire* and *Farrell et al.* teach all the limitations discussed under claim 5. Neither *PR Newswire* nor *Farrell et al.* teach determining the correction factor based on a customer indication of the geographic location of the intended use location. However, *Lonngren* teaches improving the efficiency of an air conditioner by installing it in a location that faces north (page 2). At the time of Applicants’ invention, it would have been obvious to one of ordinary skill in the art to modify *PR Newswire* and *Farrell et al.* to include the teachings of *Lonngren* in order to recommend to the customer a larger BTU capacity when the customer is unable to install the air conditioner in a location that faces north.

Regarding claim 12, *PR Newswire* and *Farrell et al.* teach all the limitations discussed under claim 11. Neither *PR Newswire* nor *Farrell et al.* expressly teach storing, in a database, a series of geographic location indicators and a series of corresponding correction factors. However, *Lonngren* teaches *Lonngren* teaches improving the efficiency of an air conditioner by installing it in a location that faces north. As noted above, *Farrell et al.* teaches a database storing a list of product characteristics. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify *PR Newswire* and *Farrell et al.* to include *Lonngren's* teaching of a series of geographic location indicators and a series of corresponding correction factors. This combination would provide for the selection of an air conditioner that has an appropriate BTU capacity for the intended use location.

6. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over a PR Newswire Article ("Air Conditioners Are More Than Cool Air," PR Newswire (July 23,1998)) ("PR Newswire") in view of *Farrell et al.* (US 6,282,518), *Lonngren* (Lonngren, B. "Get Cookin' It's Time to Put 'Cool' on the Front Burner," Chicago Tribune (May 26, 1995)) and *Sheinkopf* (Air-conditioner alphabet soup," Dallas Morning News (June 30, 1995)).**

PR Newswire, *Farrell et al.* and *Lonngren* teach all the limitations discussed under claim 12. Neither *PR Newswire*, *Farrell et al.* nor *Lonngren* expressly teach determining an intended use location climate factor based on a geographic location indicator. However, *Sheinkopf* teaches determining an acceptable BTU capacity for an air conditioner based on the climate of the intended use location. At the time of

Applicants' invention, it would have been obvious to one of ordinary skill in the art to modify *PR Newswire*, *Farrell et al.* and *Lonngren* to include the teachings of *Sheinkopf* because determining an intended use location climate factor based on a geographic location indicator would enable the customer to select an air conditioner that is best-suited for the intended use location.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over a PR Newswire Article ("Air Conditioners Are More Than Cool Air," PR Newswire (July 23, 1998)) ("*PR Newswire*") in view of *Farrell et al.* (US 6,282,518), *Steele* (Steel, J. "Don't Get Hot and Bothered About Buying AC Go to an Air-Conditioning Showroom Armed with Specific Information That Will Affect Your Cooling Needs," Chicago Tribune (July 15, 1996)) and *Lonngren* (Lonngren, B. "Get Cookin' It's Time to Put 'Cool' on the Front Burner," Chicago Tribune (May 26, 1995)).

Regarding claim 9, *PR Newswire*, *Farrell et al.* and *Steele* teach all the limitations discussed under claim 6. Neither *PR Newswire*, *Farrell et al.*, nor *Steele* expressly teach receiving a customer indication that the intended customer use location is above a cooled space. However, *Lonngren* teaches selecting an air conditioner with the appropriate BTU capacity depending upon the location of the intended use location within a house, including whether the intended use location is a lower floor. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify *PR Newswire*, *Farrell et al.* and *Steele* to include the teachings of *Lonngren*. This combination would enable the customer to select an appropriate air conditioner

when the efficiency of the air conditioner is impacted by the presence of a cooled room below the intended use location.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over a PR Newswire Article (“Air Conditioners Are More Than Cool Air,” PR Newswire (July 23,1998)) (“PR Newswire”) in view of *Farrell et al.* (US 6,282,518) and Official Notice.

PR Newswire and *Farrell et al.* teach all the limitations discussed under claim 5. Neither *PR Newswire* nor *Farrell et al.* expressly teach a database storing a series of product identifiers and corresponding ranges of BTU ratings wherein the series is divided into a range of product categories. However, the Examiner takes Official Notice that a database storing a range of products including a plurality of individual characteristics is old and well known in the art. Therefore, at the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify *PR Newswire* and *Farrell et al.* to include a database storing a series of product identifiers and corresponding ranges of BTU ratings wherein the series is divided into a range of product categories. This combination would provide the customer with a wider range of air conditioner options.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3625

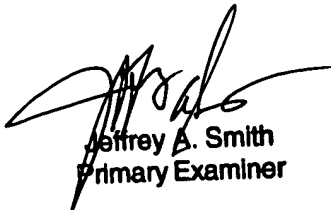
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

TMB
July 8, 2003



Jeffrey A. Smith
Primary Examiner

Tim Brown
Examiner
Art Unit 3625